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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,969

04/25/2006

Thomas Wegmann

P/3610-66

7580

2352 7590 03/19/2009
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

03/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,969	Applicant(s) WEGMANN ET AL.	
	Examiner ALTON N. PRYOR	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-28 is/are allowed.
- 6) ☐ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments filed 11/17/08 have been fully considered but they are not persuasive. See discussions below. Previous rejections not addressed below have been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an invention comprising compound Ia, i.e., 2,6-dichloro-N-{[3-chloro-(trifluoromethyl)-2-pyrindyl]methyl}benzamide plus tolylfluanid in a ratio range of 0.1 to 0.2, does not reasonably provide enablement for the invention comprising N-{[3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl}-2-fluoro-6-nitrobenzamide (compound Ib) or N-{[3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl}-2-fluoro-6-nitrobenzamide (compound Ic) plus tolylfluanid. Compounds Ib and Ic differ in chemical functionality from compound Ia. Therefore, the activity of compound Ia would not render the activity of compound Ib and Ic obvious. Small changes in chemical functionality on a chemical structure core may affect the activity of a compound. The specification is also not enabling for an invention comprising preventing or curing fungi growth. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Possession Based on Ordinary Skilled Artisan's Determination/ State of the Prior Art

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It is accepted in the art that compounds Ia, Ib, Ic and tolylfluanid are fungicides. In fact, WO 03/034824 teaches that compounds Ia, Ib and Ic are fungicides used to control (rather than prevent or cure) fungi growth and The Agricultural Handbook, 3rd edition, A0400, August 1991 teaches that tolylfluanid is a fungicide used to control (rather than prevent or cure) fungi growth. Based on these teachings, one of ordinary skill in the art would have been motivated to combine compounds Ia, Ib, or Ic with tolylfluanid expecting that the resulting combinations would show fungicidal activity.

An analysis based upon the Wands factors is set forth below.

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. In *Genentech Inc. v. Novo Nordisk* 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997); *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993),. See also *Amgen Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed. Cir. 1991); *In re Fisher* 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Further, in *In re Wands* 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) the court stated:

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman* (230 USPQ 546, 547 (Bd Pat App Int 1986)). They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art and (8) the breadth of the claims.

Breadth of Claims

Applicants' claims are to combinations of compounds Ia, Ib, or Ic with tolylfluanid in a ratio of 0.1 to 0.2.

Nature of the invention/State of the Prior Art

Claims 13-20 of the instant application which claim an invention comprising compounds Ia, Ib, or Ic with tolylfluanid in a ratio of 0.1 to 0.2 is representative of the nature of Applicants' invention. It is accepted in the art that compounds Ia, Ib, Ic and tolylfluanid are fungicides. In fact, WO 03/034824 teaches that compounds Ia, Ib and Ic are fungicides used to control fungi growth and The agricultural Handbook, 3rd edition, A0400, August 1991 teaches that tolylfluanid is a fungicide used to control fungi growth. Based on these teachings, one of ordinary skill in the art would have been motivated to combine compounds Ia, Ib, or Ic with tolylfluanid expecting that the resulting combinations would show fungicidal activity.

Level of One of Ordinary Skill & Predictability/Unpredictability in the Art

The level of a person of ordinary skill in the art is high, with ordinary artisans having advanced scientific degrees (M.S., Ph.D., or combinations thereof). There is a general lack of predictability in the fungicidal art. The art is especially unpredictable with regards to the existence and formation of compositions yielding better than additive activity for the chemical combinations set forth by the claims.

Guidance/Working Examples

Applicants provide examples depicting better than additive activity for an invention comprising compound Ia, i.e., 2,6-dichloro-N-{[3-chloro-(trifluoromethyl)-2-pyrindyl]methyl}benzamide plus tolylfluanid in a ratio range of 0.1 to 0.2 on pages 12-13 of the specification.

However, Applicants' specification does not provide better than additive activity for an invention comprising N-{[3-chloro-5-(trifluoromethyl)-2-pyrindyl]methyl}-2-fluoro-6-

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nitrobenzamide (compound Ib) or N-{{3-chloro-5-(trifluoromethyl)-2-pyrindyl}methyl}-2-fluoro-6-nitrobenzamide (compound Ic) plus tolylfluanid. The Applicants' specification also does not provide examples of how the claimed combination of ingredients would prevent or cure fungi growth.

Response to Applicants' argument

The Applicants' argue that the Examiner acknowledged that the instant three compounds (Ia, Ib, and Ic) are known fungicides and that WO '824 teaches that they are used to control fungi growth. Thus, the three fungicide compounds are equivalent and therefore, it is entirely appropriate for the claims to be directed to all three equivalents. Because the three compounds as well as tolylfluanid are well known fungicides, it is obvious that the combination of any one of the three compounds with tolylfluanid would yield a fungicide composition having at least an additive effect. Absent a showing of unexpected or synergistic results, the instant composition is made obvious by WO '824 and The Agricultural Handbook.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercer et al (WO 03/034824; 5/1/03) and The Agrochemicals Handbook, 3rd edition, A0400, August 1991. Mercer et al. teach a fungicidal composition comprising a compound of instant formula I wherein the compound of formula I can be Ia, Ib or Ic. See abstract, pages 5,6,10. Mercer teaches

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that the composition can comprise phosphorous acid derivatives such as fosetyl - Al which is aluminum ethyl hydrogen phosphonate as well as carriers. See page 14 line 26 and page 15 lines 9-15. Mercer teaches a method of applying the composition onto seed and vine plants in order to control fungi growth. See page 16 lines 7-8 and page 24 lines 23-28. Mercer does not teach the composition / method comprising tolylfluanid. However, The Agrochemicals Handbook discloses that tolylfluanid is a fungicide. It would have been obvious to modify the composition / method of Mercer to include the tolylfluanid taught by The Agrochemical Handbook. One would have been motivated to do this since Mercer is open to the inclusion of other fungicides. See Mercer page 14 lines 1-2. With respect to the amounts and ratios of ingredients, one having ordinary skill would have determined the optimum amounts and ratios of ingredients. One would have been motivated to do this in order to develop an invention that would have been most effective in controlling fungi. It is possible that the optimum amounts / ratios of ingredients determined for the instant invention could have fallen within the instant ratios and amounts. The specification provides unexpected (synergistic) results for the composition / method comprising a compound of formula Ia, i.e, 2,6-dichloro-N- {[3-chloro-(trifluoromethyl)-2-pyrindyl]methyl}benzamide and tolylfluanid in a ratio range from 0.1 to 0.2. However, the claims are not commensurate in scope with the unexpected results.

Response to Applicants' argument

The Applicants' argue that the instant three compounds (Ia, Ib, and Ic) are known fungicides and that WO '824 teaches that they are used to control fungi growth. Thus, the three fungicide compounds are equivalent and therefore, it is entirely appropriate for the claims to be directed to all three equivalents. Limiting the Applicants' claims to only one of the three art

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recognized equivalent compounds would be unfair to the teaching of the instant invention. The Examiner argues that because the three compounds as well as tolylfluanid are well known fungicides, it is obvious that the combination of any one of the three compounds with tolylfluanid would yield a fungicide composition having at least an additive effect. Absent a showing of unexpected or synergistic results, the instant composition is made obvious by WO '824 and The Agricultural Handbook.

Allowable Subject Matter

Claims 21-28 are allowable. Applicants provide synergistic data for a composition comprising 2,6-dichloro-N-{{3-chloro-(trifluoromethyl)-2-pyrindyl}methyl}benzamide and tolylfluanid in a ratio range from 0.1 to 0.2.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616